

REMARKS

The application has been reviewed in light of the Office Action dated May 4, 2005. Claims 1-58 are pending. By this Amendment, new dependent claims 59-74 have been added, and claims 1-58 have been amended to place the claims in better form for examination and clarify the claimed invention. Accordingly, claims 1-74 are now pending, with claims 1, 10, 19, 28, 37, 46, 55 and 56 being in independent form.

Claims 1-58 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite.

By this Amendment, claims 2-9, 11-18, 20-27, 29-36, 38-45, 47-54, 57 and 58 have been amended to place the claims in better form for examination.

With regard to the claim term “image information”, the term in claims 1, 10, 19, 28, 37, 46, 55 and 56 refers to an image.

The term “MDN” is used generally in connection with a system defined by RFC 2298 of IETF (Internet Engineering Task Force), in which a notification is sent to a sender to notify him of whether e-mail sent by the sender reached a destination. When the e-mail is read at the destination, a mail software program (for example, MUA), referred to as a mailer, or a mail soft, sends back to the sender a return e-mail in which its header includes information of receipt acknowledgement.

The term “DSN” in claims 5, 14, 23, 32, 41 and 50 refers to delivery status notification.

Withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 1, 2, 5, 8-11, 14, 17, 18, 28, 29, 32, 35, 36, 46, 47, 50 and 53-57 were rejected under 35 U.S.C. § 102(e) as purportedly anticipated by U.S. Patent Application Publication No.

2002/0144154 (Tomkow). Claims 3, 6, 7, 12, 15, 16, 19-21, 23-27, 30, 33, 34, 37-39, 41-45, 48, 51, 52 and 58 were rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Tomkow. Claims 4, 13, 22, 31, 40 and 49 were rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Tomkow in view of U.S. Patent Application Publication No. 2001/0005268 (Eguchi).

Applicant has carefully considered the Examiner's comments and the cited art, and respectfully submits that independent claims 1, 10, 19, 28, 37, 46, 55 and 56 are patentable over the cited art, for at least the following reasons.

This application relates to techniques for performing receipt acknowledgement of an electronic mail including image information. More specifically, the claimed invention of the present application provides for creating a return mail for acknowledging receipt of the electronic mail. The return mail can include assorted information, including, for example, information indicating successful or unsuccessful transmission of the E-mail, a predetermined page of the image information included in said E-mail if the transmission of the E-mail is successful, and the original E-mail in its entirety if the transmission of the E-mail is unsuccessful. These features are included in each of independent claims 1, 10, 19, 28, 37, 46, 55 and 56, as amended.

Regarding the Tomkow reference, it is noted that it has not been demonstrated that Tomkow is prior art to the claimed invention.

The present U.S. application was filed January 23, 2002, and claims priority from Japanese priority application 2001-015278, filed January 24, 2001.

Tomkow is a publication of an application filed February 22, 2002. Since the Tomkow application is filed later than the present application, Tomkow is not prior art to the present

application.

Tomkow claims the benefit of provisional applications filed December 6, 2000, January 23, 2001 and March 12, 2001. However, since the Tomkow application was filed more than one year after the December 6, 2000 and January 23, 2001 provisional applications, the December 6, 2000 and January 23, 2001 provisional applications were abandoned by the time the Tomkow application was filed on February 22, 2002, and therefore the Tomkow reference is not entitled to the December 6, 2000 and January 23, 2001 filing dates of the December 6, 2000 and January 23, 2001 provisional applications.

In addition, the March 12, 2001 provisional application must disclose or suggest the claimed invention of this application in order for the Tomkow reference to be entitled to the March 12, 2001 filing date of the March 12, 2001 provisional application with respect to the claimed invention of this application. The Office Action neither states nor demonstrates that the March 12, 2001 provisional application discloses or suggests the claimed invention of this application.

Further, Tomkow does not disclose or suggest creating a return mail for acknowledging a receipt of the electronic mail, including in the return mail information indicating successful or unsuccessful transmission of the E-mail, attaching to the return mail a predetermined page of the image information included in said E-mail, if the transmission of the E-mail is successful, and attaching to the return mail the original E-mail in its entirety if the transmission of the E-mail is unsuccessful, as provided by the claimed invention of the present application.

Eguchi, as understood by Applicant, is directed to techniques for determining the sender of an e-mail message when preparing to send a reception acknowledgement from a recipient or a network node in response to the e-mail.

Applicant does not find disclosure or suggestion in the cited art, however, of, creating a return mail for acknowledging a receipt of the electronic mail, including in the return mail information indicating successful or unsuccessful transmission of the E-mail, attaching to the return mail a predetermined page of the image information included in said E-mail, if the transmission of the E-mail is successful, and attaching to the return mail the original E-mail in its entirety if the transmission of the E-mail is unsuccessful, as provided by the claimed invention of the present application.

Accordingly, for at least the above-stated reasons, Applicant respectfully submits that independent claims 1, 10, 19, 28, 37, 46, 55 and 56, and the claims depending therefrom, are patentable over the cited art.

In view of the amendments to the claims and remarks hereinabove, Applicant submits that the application is now in condition for allowance. Accordingly, Applicant earnestly solicits the allowance of the application.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition. The Office is hereby authorized to charge any fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully submitted,



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